

REMARKS

The Office action of 26 July 2005 (Paper No. 20050719) has been carefully considered.

Claims 51 and 56 are being canceled without prejudice or disclaimer, claims 50, 55, 57 and 60 are being amended, and new claims 62 thru 64 are being added. Thus, claims 50, 52 thru 55 and 57 thru 64 are pending in the application.

In paragraph 2 of the Office action, the Examiner objected to claim 57 for an informality. Specifically, the Examiner objected to the presence of the semi-column at the end of the claim. Claim 57 is being amended to replace the semi-column with a period, and thus the objection no longer applies, and should be withdrawn.

In paragraph 4 of the Office action, the Examiner rejected claims 50, 52, 55, 57 and 58 under 35 U.S.C. §102 for alleged anticipation by Shimura *et al.*, U.S. Patent No. 5,966,279. In paragraph 5 of the Office action, the Examiner rejected claim 59 under 35 U.S.C. §102 for alleged anticipation by Yokoyama *et al.*, U.S. Patent No. 5,479,098. In paragraph 7 of the Office action, the Examiner rejected claims 51 and 56 under 35 U.S.C. §103 for alleged unpatentability over Shimura *et al.* '279 in view of Kataoka *et al.*, U.S. Patent No. 6,327,104. In paragraph 8 of the Office action, the Examiner rejected claim 53 under 35 U.S.C. §103 for alleged unpatentability over Shimura *et al.* '279 in view of

Yamashita, U.S. Patent No. 5,018,036. In paragraph 9 of the Office action, the Examiner rejected claims 60 and 61 under 35 U.S.C. §103 for alleged unpatentability over Yokoyama *et al.* '098 in view of Shimura *et al.* '279. For the reasons stated below, it is submitted that the invention recited in the claims, as now amended, is distinguishable from the prior art cited by the Examiner so as to preclude rejection under 35 U.S.C. §102 and/or §103.

Independent claim 50 is being amended to include the recitation from dependent claim 51, which is being canceled. Accordingly, independent claim 50 now recites that the determining unit compares a signal level of an envelope of the signal reproduced from the medium with a reference signal level.

In paragraph 7 of the Office action, with respect to the rejection of claim 51, the Examiner stated that “Shimura fails to explicitly teach that said determining unit compares a signal level of an envelope of the signal reproduced from the medium with a reference signal level” (quoting from paragraph 7, lines 4-5 of the Office action). The Examiner then cited Kataoka *et al.* '104 as allegedly disclosing (at column 1, lines 28-34) the feature not taught by Shimura *et al.* '279. However, Kataoka *et al.* '104 discloses (at column 1, lines 27-35) that “the amplitude value of reproduced signal at the time of deterioration of video recording quality and the envelope of reproduced signal are compared” (quoting from column 1, lines 28-30 of Kataoka *et al.* '104). This is not the

same as the feature of the present invention, in that the invention does not call for an envelope of one signal to be compared to an envelope of another signal, but rather it calls for a signal level of an envelope of the signal reproduced from the medium to be compared with a reference signal level.

Furthermore, there is no disclosure or suggestion whatsoever in Shimura *et al.* '279 (and the Examiner has not cited any disclosure or suggestion in the primary reference) which would motivate or instruct a person of ordinary skill in the art, upon reviewing the disclosure of Shimura *et al.* '279, to seek and obtain the disclosure of Kataoka *et al.* '104, and to modify the disclosure of Shimura *et al.* '279 in accordance with the teaching of Kataoka *et al.* '104. It is respectfully submitted that the only reason that the Examiner has been able to combine the references in the manner suggested in the Office action is that the Examiner, unlike a person of ordinary skill in the art as of the invention date, has had the benefit of reviewing the disclosure of the present application, and thus has combined these references by improper hindsight. The latter practice is not a proper practice when combining references under 35 U.S.C. §103. For this reason, it is submitted that the invention recited in independent claim 50, as now amended, is distinguishable from the prior art so as to preclude rejection under 35 U.S.C. §102 or §103.

In paragraph 4 of the Office action, independent claims 52 and 57 are rejected

under 35 U.S.C. §102 for alleged anticipation by Shimura *et al.* '279, the Examiner alleges that Shimura *et al.* '279 discloses an apparatus for detecting abnormalities, the apparatus comprising a plurality of heads for recording data onto a medium and reproducing data from the medium (citing column 1, lines 13-19 of the patent). The Examiner further alleges that Shimura *et al.* '279 discloses a controlling unit for controlling the plurality of heads to reproduce a signal from the medium while the signal is being recorded onto the medium (citing column 2, lines 36-39). Finally, the Examiner alleges that Shimura *et al.* '279 discloses a determining unit for determining an abnormality in the recorded signal in dependence upon a result obtained when comparing the signal reproduced from the medium with a reference signal (citing column 2, lines 60-67 of the patent).

However, the cited portions of Shimura *et al.* '279 do not disclose or suggest each and every element and function or characteristic of the invention, as recited in independent claims 52 and 57.

In particular, it is noted that both claim 52 and claim 57 recite that the third head is formed on the head drum and is disposed between the first and second heads. At no point in the disclosure of Shimura *et al.* '279 is such an arrangement disclosed or suggested. Furthermore, whereas there is reference in Shimura *et al.* '279 to heads having different azimuth angles, there is no specific disclosure or suggestion of a first head, a second and

a third head, with the first and second heads having different azimuth angles, and with the third head being disposed between the first and second heads, as recited in claim 52. For the above reasons, independent claims 52 and 57 recite the invention in a manner distinguishable from the prior art so as to preclude rejection under 35 U.S.C. §102 or §103.

Independent claim 53 is rejected under 35 U.S.C. §103 based on Shimura *et al.* '279 in combination with Yamashita '036. The reasons for the rejection are set forth in paragraph 8 on pages 5 and 6 of the Office action. On page 6 of the Office action, the Examiner admits that Shimura *et al.* '279 fails to explicitly teach the subject matter recited in lines 8 thru 18 of the claims, that is, that Shimura *et al.* '279 fails to disclose or suggest a major portion of the recitation of independent claim 53.

However, the Examiner cites Yamashita '036 as allegedly disclosing the major portion of claim 53 not taught or suggested by Shimura *et al.* '279. In alleging that Yamashita '036 recites a major portion of the recitation of independent claim 53, the Examiner (on page 6 of the Office action) merely cites column 4, lines 35-42 of Yamashita '036. That is to say, the Examiner merely cites eight lines in column 4 of Yamashita '036 as disclosing the subject matter recited in the last eleven lines of claim 53. Moreover, a review of column 4, lines 35-42 of Yamashita '036 fails to disclose the recited first, second and third heads with the characteristics and functions of those heads

as recited in the last eleven lines of claim 53. Thus, even if one of ordinary skill in the art, upon reviewing Shimura *et al.* '279, were motivated and instructed to obtain and incorporate the disclosure of Yamashita '036 into the disclosure of Shimura *et al.* '279, the result would not correspond to the invention as recited in independent claim 53. However, it should be noted that there is nothing in the disclosure of Shimura *et al.* '279 (and the Examiner has not cited anything within the disclosure) which would motivate a person of ordinary skill in the art to seek and obtain the disclosure of Yamashita '036, much less to modify the disclosure of Shimura *et al.* '279 in accordance with the disclosure of Yamashita '036. For the above reasons, it is submitted that the rejection of independent claim 53 based on the combination of Shimura *et al.* '279 and Yamashita '036 is an improper rejection under 35 U.S.C. §103 and should be withdrawn.

In paragraph 5 of the Office action, the Examiner rejects claim 59 under 35 U.S.C. §102 for alleged anticipation by Yokoyama *et al.* '098. The Examiner cites Figures 11 and 12, as well as column 2, lines 52-56 and column 3, lines 44-47 of Yokoyama *et al.* '098. However, these cited portions of Yokoyama *et al.* '098 do not disclose or even suggest the invention as recited in independent claim 59.

Specifically, whereas the Examiner alleges that the controller 10 of Figure 1 of Yokoyama *et al.* '098 outputs first and second switching signals, and whereas the Examiner alleges that Yokoyama *et al.* '098 discloses the operating of a first switch to

activate a first head to record first data onto a medium (citing column 3, lines 44-47 of the patent), there is no disclosure or suggestion of a second switch with the functions and characteristics recited in independent claim 59. In that regard, the Examiner does allege (on page 4 of the Office action) that Yokoyama *et al.* '098 discloses a second switch operating in response to a second switching signal, the operating of the second switch to activate a second head to reproduce second data, the Examiner cites basically the same portion of text of Yokoyama *et al.* '098 (column 3, beginning at lines 44 or 45) as was cited with respect to the disclosure of a first switch. In actuality, Figure 1 of Yokoyama *et al.* '098 merely discloses a single switch 22 connected between a controller 20 and a read circuit 18, and receiving an output from the head 8. Thus, it is doubtful that switch 22 activates the head 8.

The Examiner also cites Figures 11 and 12 of the patent. Figure 12 of the patent does disclose switches 96 and 98 connected between controllers 10 and 10', on the one hand, and read circuits 18 and 18', on the other hand, but there is no disclosure or suggestion in Yokoyama *et al.* '098 of the precise functions of the switches 96 and 98. In that regard, the switches 96 and 98 are referred to in a single sentence (appearing at column 5, lines 37-40 of the patent), and there is no discussion whatsoever as to the function of the switches 96 and 98.

Finally, Figure 3 of the patent discloses switches 52 and 54 connected between a

single head 50 and a read circuit 34. However, it is clear from the discussion of Figure 3 contained in the patent that the switches 52 and 54 do not activate first and second heads, respectively, as recited in independent claim 59.

Thus, for the reasons stated above, it is submitted that the invention recited in independent claim 59 is distinguishable from the prior art so as to preclude rejection under 35 U.S.C. §102 or §103.

Finally, the dependent claims provide further bases for distinguishing the invention from the prior art. In that regard, the Examiner's attention is directed to new dependent claims 62 thru 64 of the present application.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

No fee is incurred by this Amendment.

Respectfully submitted,



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